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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,385	12/12/2001	Kevin P. Baker	GNE.2830P1C51	9906
30313	7590	06/09/2005	EXAMINER	
KNOBBE, MARTENS, OLSON & BEAR, LLP 2040 MAIN STREET IRVINE, CA 92614			MCKELVEY, TERRY ALAN	
			ART UNIT	PAPER NUMBER
			1636	
DATE MAILED: 06/09/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/015,385

Applicant(s)

BAKER ET AL.

Examiner

Terry A. McKelvey

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

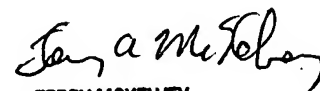
AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: the applicant's arguments are not persuasive and thus the rejection remains of record. The applicant argues that the longest of the DNA fragments disclosed in Yousef et al is only 260 base pairs (which is smaller than the 744 base pairs of SEQ ID NO:194). This argument is completely non-persuasive because as the rejection of record clearly indicates, the rejection is based upon the Yousef et al disclosure of "Reversed contig 37" in Figure 1 and Table VI. As Figure 1 clearly teaches, Reversed contig 37 is 80 Kb (80,000 base pairs) in length, much longer than the just 260 base pairs alleged by the applicant. As the rejection clearly indicates, Reversed contig 37 is an isolated genomic clone which encodes KLK-L5, which is shown in Figure 1 as encoding KLK-L5 as indicated by the arrow showing the transcriptional unit for the gene. The applicant argues that Yousef et al does not disclose the complete amino acid sequence of SEQ ID NO:194, but only short portions of the protein sequence and in fact only discloses sequences of three predicted exons each only having very little identity to the entire 248 amino acid sequence of SEQ ID NO:194 and provide methods by which these fragments of the SEQ ID NO:194 sequence could later be used to determine the sequence of nucleic acids encoding the full length protein. The applicant argues that knowledge of a protein sequence along with methods for using this sequence to isolate an encoding DNA sequence does not render the encoding DNA obvious. This argument is not persuasive because it is a total misrepresentation of the basis of the rejection which is an anticipation rejection, not an obviousness rejection based upon a partial protein sequence and method of isolating a DNA encoding the full length protein. The applicant is totally ignoring the actual basis of the rejection, that the reference teaches Reversed contig 37 which inherently encodes SEQ ID NO:194 as shown by the sequence comparison of record. The rejection is not based upon using fragments of SEQ ID NO:194 to identify the full length protein because the reference already teaches a genomic DNA that does encode KLK-L5, which consists of SEQ ID NO:194 as shown by the sequence comparison of record. The claimed invention is drawn to an isolated nucleic acid which encodes a polypeptide having 100% sequence identity to SEQ ID NO:194. Yousef et al does teach that nucleic acid, as shown by their teaching of Reversed contig 37, which is an 80 Kb genomic DNA which comprises an open reading frame, "KLK-L5" which is shown (in the sequence comparison) to consist of a polypeptide that is 100% identical to SEQ ID NO:194. An isolated DNA does not differ based upon whether the sequence of the DNA or the protein encoded by the DNA is determined and taught or not. The sequence is merely a precise chemical description of the nucleic acid molecule that can be taught without indicating the sequence. The sequence of the DNA is inherent to the DNA itself and does not have to be taught in order for a reference teaching the DNA itself anticipate claims drawn to a DNA having the same sequence. So, the teaching of Reversed contig 37 by Yousef et al anticipates the claimed invention because as shown by the sequencing of Reversed contig 37, it inherently encodes a sequence that is 100% identical to SEQ ID NO:194. The applicant keeps repeating that the Examiner has admitted that the precise polypeptide sequence and isolated complete protein is not taught by the reference, as the basis for arguing that Yousef et al does not disclose every element set forth in the claims. This argument is not persuasive for the reasons described above and in the last Office Action. An isolated DNA having a particular sequence limitation is what is being claimed, not an isolated protein. Yousef et al does not disclose full sequence information concerning Reversed contig 37, but the reference does teach that isolated nucleic acid itself and the Examiner provides the extrinsic evidence why the Reversed contig 37 nucleic acid encodes SEQ ID NO:194; that evidence is that Reversed contig 37 encodes KLK-L5, which is shown in the sequence comparison of record to consist of a sequence that is 100% identical to SEQ ID NO:194. So, when Yousef et al teaches Reversed contig 37, it is teaching an isolated DNA that encodes a polypeptide sequence that is 100% identical to SEQ ID NO:194, as claimed, anticipating the claimed invention. Applicants argue that Yousef et al do not inherently disclose the claimed nucleic acid sequence or its encoded polypeptide sequence, arguing that an inherent property must necessarily be present in the invention described by the prior art and it must be so recognized by person of ordinary skill in the art. The applicant argues that the precise polypeptide sequence and isolated protein is not taught by Yousef et al and that Yousef et al teach about their strategy for identifying new genes, the preliminary exon structure and partial protein sequence, and the predicted exons of KLK-L5, and concludes that they are now screening EST clones and that their goal is to fully characterize their mRNA sequence. The applicants argue that without the explicit description of the sequence, Yousef et al does not provide sufficient information about the nucleic acid or polypeptide sequences to allow one skilled in the art to recognize that the undisclosed portions of SEQ ID NO:194 must necessarily be present. This argument is not persuasive because again, applicants are totally ignoring the basis of the rejection, that the teaching of Reversed contig 37 anticipates the claimed invention. Reversed contig 37 is taught as being an 80 Kb isolated genomic clone which is shown as totally containing the transcriptional unit for KLK-L5. The sequence of KLK-L5 is shown to consist of a sequence that has 100% identity to SEQ ID NO:194 (as shown by the sequence comparison of record). One of ordinary skill in the art would clearly recognize that Reversed contig 37 which has the entire transcription unit of KLK-L5, which is shown by the sequence comparison to consist of SEQ ID NO:194 (the protein encoded by KLK-L5), must therefore encode a polypeptide having a 100% sequence identity to SEQ ID NO:194. Therefore, one of ordinary skill in the art would recognize that Yousef et al which teaches Reversed contig 37 inherently teaches the claimed invention. In conclusion, the applicant's total lack of addressing the actual basis of the rejection of record (i.e., the teaching of the isolated nucleic acid Reversed contig 37 which encodes KLK-L5) makes the applicant's arguments non-persuasive because the real reason the claimed invention is anticipated is not addressed by the applicant.


TERRY MCKELVEY
PRIMARY EXAMINER